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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER  
FORD, J

ART UNIT	PAPER NUMBER
1202	6

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

DATE MAILED: 01/10/94

☐ This application has been examined ☒ Response to communication filed on 10-22-93 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.  | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1--3, 5--9, 11--15 and 16--32 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1--3, 5--9, 11--15 and 16--32 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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Applicants response of October 22, 1993, is noted.

The claims in the application are claims 1-3, 5-9, 11-15 and 18-32.

Applicants election of Group II, the 1, 2 thiazines of Claim 19 is noted.

The additional subject matter noted by applicants is considered non-elected subject matter. Variations of ring size or G values creates other patentably distinct compounds.

Claims 1, 7, & 13 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A)  $R_1$  and  $R_3$  together were elected as 6 membered rings of Claim 19. The claim need be amended.

(B) The use of "such as" is not acceptable in a claim.

In  $R_5$  &  $R_6$  together "such as" need be replaced with: said ring is selected from the group consisting of.

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Likewise, in R<sub>10</sub> "such as" need be replaced with: selected from the group consisting of.

(C) The election was to compounds of claim 19. Therefore, what was elected here is a G value of SO<sub>2</sub>. The claim need be amended. Applicants are entitled to the protection of 35 U.S.C. 121 in regard to the non-elected subject matter.

All claims are rejected as not being patentably distinct from the claims of applicants allowed application Serial Number 775,313. Stereo-chemistry is not set forth in most of the claims here. Therefore, the broadest possible reading of the claim makes them overlap the claims of now U.S. Patent 5,240,923. Applicants argument in regard to the racemic form of a compound within claim 19 is noted. However, optical isomers are not usually patentable over the racemate; In re Adamson, 125 USPQ 233. The  $\alpha$ -d form was held within the scope of the  $\alpha$ -dl form of the same compound, in Eli Lilly vs. Generic Drug Sales, 169 USPQ 13.

Therefore, the present claims are within the claims of 5,240,923 (a 35 USC 101 rejection), and are rejected on the grounds of obviousness-type double-patenting, as well.

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Claims 2, 8, & 14 are not understood. What other position could R<sub>3</sub> be in, but in the 4 position? What other position could -GN<sup>1</sup><sub>2</sub> be in, but in the 5 position?

The present formula are, therefore, over stated in their being drawn as floating radicals.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

The Gronowitz Article has been considered, but is not citable without a year of publication. Please provide the year of publication of this work.

All claims are rejected as not being patentably distinct from the claims of applicants U.S. Patent 5,153,192. Compare the claim<sup>1</sup><sub>1</sub> of the patent to claim 19 here. Compare claims 4-11 of the patent to claims 20-32, here. No patentable distinction is seen.

The third compound from the end of claim 19 is a 2-propyl of the same compound that is the 2-methyl, that is the first compound of claim 1 of U.S. Patent 5,153,192. This is extremely close, in an otherwise identical molecule, for the same use. The first compound of claim 19 is extremely close to the 2(2-methoxy ethyl) compound that is penultimate in the list of claim 1 of US 5,153,192 - that is an ethyl vs. propyl variation. Next adjacent

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compounds are obvious from one another. A terminal disclaimer is minimally required.

Claim 1 is rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

$R_1$  and  $R_3$  form a six membered ring, note the examples.  $R_2$  then become the substitution on the 2 position of this 1, 2-thiazine with G as  $SO_2$ .  $R_3$  is employed in the ring formation. This does not then provide for any substitution in the 4-position. Therefore, none of the species of claim 19 fall under claim 1, here. O.K., fine - the species of claim 19 are written in independent form and do not have to fit under the genus of claim 1. No problem - right? The problem is support (representative exemplification) for claim 1 in the specification. Example 2 on page 26 has no substitution in the 4 position. Therefore, Example 2 falls within claim 1. However, that Example could not be the basis, the exemplification, of a claim the size of claim 1.

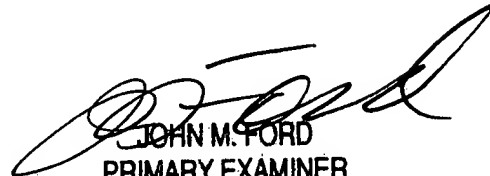
Serial No. 08/019,011

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Ford: ach  
December 30, 1993



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PRIMARY EXAMINER  
GROUP 120